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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,706	06/21/1999	SUMIYO OKADA	21.1924/JRB	7969

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EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 10/01/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/336,706

Applicant(s)

OKADA, SUMIYO ET. AL.

Examiner

B. Prieto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

ELECTION/RESTRICTION

1. This communication is in response to amendment filed 01/16/03; claims 1-22 remain pending and are hereby set forth for examination.

2. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claim 1 is drawn to a method of displaying messages with a chat client in an information exchange system for transmitting and receiving the messages, the chat client transmitting and receiving the messages through at least two chat networks, classified in class 345, subclass 758.

II. Claim 2 is drawn to an information exchange system in which user terminals are configured for connection to a plurality of chat networks to transmit and receive messages through the plurality of chat networks, the user terminals having a message display area displaying messages transmitted and received to or from each of the plurality of chat networks, classified in class 345, subclass 759.

III. Claim 3 is drawn to a an information exchange system in which user terminals are configured for connection to a plurality of chat networks to transmit and receive messages through the plurality of chat networks, the user terminals having a message display area displaying messages transmitted and received to/from each of the plurality of chat networks, classified in class 345, subclass 1.2.

IV. Claims 13-15 are drawn to a method for concentrating a plurality of messaged obtained to be transmitted or received by a chat client and independently displaying the concentrated messaged together in a discrete display area in a time series basis, classified in class 345/1.3.

V. Claim 18 is drawn to a method for displaying messages in a chat client, including connecting the chat client to a first chat channel of a first chat network; connecting the chat client to a second chat channel of a second chat network; and displaying in a discrete display area of the client, messages received by the chat client from the first and second chat channels, classified in class 345/734.

VI. Claim 21 is drawn to a method for displaying chat messages, including changing a chat client's current active chat network from a first chat network to a second chat network in response to and based on interactively selecting a previously displayed chat message of the second chat network, classified in class 345/700.

VII. Claim 22 is drawn a chat client simultaneously connecting to at least two distinct and autonomous chat networks, including a first message display area capable of displaying only chat messages of a first of the chat networks; a second message display area capable of displaying only messages of a second of the chat networks; and a third message display area simultaneously displaying

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some messages of the first chat network and some messages of the second chat network, where the client responds to interactively selecting the first chat network by displaying or making active the first message display area, classified in class 345/676.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

In the instant case, Invention I has separate utility such as it is usable in a method of displaying messages with a chat client in an information exchange system for transmitting and receiving the messages, which lack the features of Invention II, such as message displaying means for the user terminals that are configured for connection, for displaying the messages acquired in a discrete display area independent of the message display area of each of the plurality of chat networks, not required for Invention I. Also lacking features of invention III, such as transmission cooperating means of the client for transmitting one of the messages, identifying messages for transmission to one of the chat networks. Also lacking features of Invention IV such as displaying independently messaged that are concentrated in a discrete display area in a time series basis, not required for Invention I.

Invention III has a separate utility such as information exchange system in which user terminals are configured for connection to a plurality of chat networks to transmit and receive messages through the plurality of chat networks, the user terminals having a message display area displaying messages transmitted and received to/from each of the plurality of chat networks, which lacks features of Invention I, such as displaying messages of both chat network in a discrete display area independently of another display area for displaying messages of only one chat network, the discrete display area is separate from another display area that is dedicated to the active chat network, as required for Invention I. Also lacking features of Invention IV such as displaying independently messaged that are concentrated in a discrete display area in a time series basis, not required for Inventions I-II.

Invention V has a separate utility such as a method for displaying messages in a chat client, including connecting the chat client to a first chat channel of a first chat network; connecting the chat client to a second chat channel of a second chat network; and displaying in a discrete display area of the client, messages received by the chat client from the first and second chat channels, these features are not required for Inventions I-IV.

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Invention VI has a separate utility such as a method for displaying chat messages, including changing a chat client's current active chat network from a first chat network to a second chat network in response to and based on interactively selecting a previously displayed chat message of the second chat network, these features are not required for Inventions I-V and VII.

Invention VII has a separate utility such as chat client simultaneously connecting to at least two distinct and autonomous chat networks, a first message display area capable of displaying only chat messages of a first of the chat networks; a second message display area capable of displaying only messages of a second of the chat networks; and a third message display area simultaneously displaying some messages of the first chat network and some messages of the second chat network, where the client responds to interactively selecting the first chat network by displaying or making active the first message display area, these features are not required for Inventions I-IV. See MPEP §806.05(d).

4. Because these inventions are distinct for the reasons given above and because the search required for each group is different and not co-extensive for examination purpose because these groups would require different searches on PTO's classification class and subclass e.g. Invention I requires a search, classified in class 345, subclass 758, Invention II requires a search in class 345, subclass 759, Invention III requires a search in class 345, subclass 1.2, Invention IV requires a search in class 345, subclass 1.3, Invention V requires a search in class 345, subclass 734, Invention VI requires a search in class 345, subclass 700, Invention VII requires a search in class 345, subclass 676, therefore restriction for examination purposes as indicated is proper.

5. Restriction is required under 35 U.S.C. §121 to one of the above-identified patentably distinct groups of designs. A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held non-responsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions, which are directed to the non-elected.

6. Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting

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patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

7. In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with Ex parte Heckman, 135 USPQ 229 (P.O. Super. Exam. 1960).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark R. Powell can be reached on (703) 305-9703. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".


B. Prieto
TC 2100
Patent Examiner
September 24, 2003

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER